

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application: Shrader et al.

Serial No.: 09/578,751

Filed: May 25, 2000

For: Client-Side Pricing Agent for  
Collecting and Managing Product  
Price Information Over the Internet§  
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Group Art Unit: 3627

Examiner: Fischer, Andrew J.

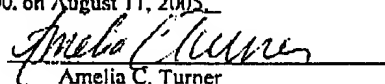
Attorney Docket No.: AUS000168US1

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8300, on August 11, 2005.

By:

  
Amelia C. Turner

## PETITION FOR WITHDRAWAL OF FINAL REJECTION

I hereby petition to withdraw the final rejection, on the basis that finality is improper due to new grounds of rejection that are not necessitated by any amendment made by Applicants.

The Final Office Action issued June 3, 2005, rejects claims 3, 4, and 6 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. More particularly, with respect to claim 3, the Final Office Action states:

- a. Claim 3 recites the limitation "the associated price data" in line 2. It is unclear if "the associated price data" is the same or different from "an associated price value" as recited in claim 1. Applicants are reminded that "semantic indefiniteness of claims is not rendered unobjectionable merely because it *could* have been corrected. [Emphasis in original.]" *Allen Engineering Corp. v. Bartell Industries, Inc.*, 299 F.3d 1336, 1349, 63 USPQ2d, 1776 (Fed. Cir. 2002) (citations and quotations omitted).

In this case, and by way of example only, the Examiner suggests (in Applicants' next appropriately filed response) changing in claim 3 "the associated price data" to --the associated price value-- if Applicants' specification supports such an amendment. To be clear, this solution is only a *suggestion* and is not a requirement mandated by the Examiner. Other solutions clearly exist and like all claim decisions, it is up to Applicants to select the best choice for their claims.

The Final Office Action also states that Applicants' amendment necessitated the new grounds of rejection. Applicants submit that no amendment made in this application necessitated the new grounds of rejection for claim 3, as shown below.

Original claim 1 recited:

1. A method of collecting product data, comprising the steps of:  
generating a profile identifying a given site URL, an item to be queried, and a scan interval;  
on a periodic basis as defined by the scan interval, retrieving data from the given site URL; and  
parsing the retrieved data according to a site template to generate a data record comprising an item name and an **associated price value**.  
[emphasis added]

Original claim 3 recited:

3. The method as described in claim 1 further including the step of:  
comparing the **associated price data** to a given threshold; and  
taking a given action if the price data has a given relationship to the given threshold condition. [emphasis added]

As seen above, the new grounds for rejection could have been made in the very first office action. The reasons for not presenting the rejection in any of the four previous office actions are not relevant. The fact presented here is that no amendment made by Applicants necessitated the new grounds of rejection found in the Final Office Action issued June 3, 2005.

In consideration of this submission, it is respectfully requested that the final rejection be withdrawn, and the office action be re-issued as a non-final office action, so that Applicants are afforded a fair opportunity to address the new grounds of rejection. Of concern is the following passage from the Final Office Action:

Because this application is now final, Applicants are reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. "The refusal of an examiner to enter an amendment after final rejection of claims

is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that-- suggestions or examples--and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is "allowed," exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (e.g. §101 patentable subject matter, §112 1st paragraph written description and enablement, §112 2nd paragraph indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

Form the above, as well as the previous example of the Examiner's discretion in the Advisory Action issued August 2, 2004, for example, Applicants are concerned that they will not be afforded a fair opportunity to address the new grounds of rejection.

Therefore, Applicants respectfully request that the final rejection be withdrawn and that the office action be reissued as anon-final action. No fees are believed to be necessary. If, however, any fees are required, I authorize the Commissioner to charge these fees which may be required to IBM Corporation Deposit Account No. 09-0447.

Respectfully submitted,



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To: Commissioner for Patents for <b>Examiner Andrew J. Fischer</b> <b>Group Art Unit 3627</b>	Facsimile No.: <b>571/273-8300</b>
From: <b>Amelia Turner</b> <b>Legal Assistant to Stephen R. Tkacs</b>	No. of Pages Including Cover Sheet: <b>5</b>
Message:  Transmitted herewith: <ul style="list-style-type: none"><li>• Transmittal Document; and</li><li>• Petition for Withdrawal of Final Rejection.</li></ul>	
Re: Application No.: <b>09/578,751</b> Attorney Docket No: <b>AUS000168US1</b>	
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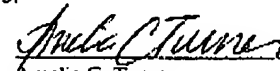
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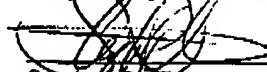
Sir:

TRANSMITTED HERewith:

- Petition for Withdrawal of Final Rejection

No fees are believed to be required. If, however, any fees are required, I authorize the Commissioner to charge these fees which may be required to IBM Corporation Deposit Account No. 09-0447. No extension of time is believed to be necessary. If, however, an extension of time is required, the extension is requested, and I authorize the Commissioner to charge any fees for this extension to IBM Corporation Deposit Account No. 09-0447.

Respectfully submitted,



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